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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09 826,012 | 04 05 2001 | Kenichi Chino | 0303-0444P | 3847 |

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EXAMINER

CHANG, VICTOR S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1771

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DATE MAILED: 10 08 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,012

Applicant(s)

CHUJO ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-2, in Paper No. 6 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0331447.

EP '447 is directed to a molded laminated article made from (a) a composite comprising a crosslinked polyolefin resin foam having an average expansion ratio of 5 to 40, in which the average expansion ratio on the side of one surface of the foam is

larger than the average expansion ratio on the side of the other surface, and the difference between the average ratios is from 2 to 20, and a skin material is bonded to the surface having the larger average expansion ratio, and (b) a thermoplastic resin as a skeleton material (pg. 3, Ins. 13-20). EP '447 also teaches that the article is formed by a compression molding process (pg. 3, Ins. 20-24), and it is believed that evacuating gas from mold cavity for compression molding a laminated foamed article is a necessary process step in article formation. In Comparative Example 1, EP '447 teaches that the skin material is bonded to the small average expansion ratio side of the polyolefin foam, and the results summarized in Table 1 shows that, under suitable molding pressure, the composite is still of practical use (pg. 8, Ins. 7-36). Claims lack novelty.

The Examiner believes that the product-by-process recitation in claims 1-2 is either inherent in an article formed by a compression molding process, or an obvious modification to one of ordinary skill in the art, which further has not as yet been shown on the record to produce a patentably distinct article. Alternatively, note also that EP '447 teaches that in the prior art removing the air from the mold cavity by vacuum is a conventional process step during compression molding (pg. 2, Ins. 20-25). As such, if the reference is not anticipating, it would still have been obvious to one of ordinary skill to form the article by including an evacuation step in a compression molding process, motivated by the desire to fill the mold properly.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0331447 in view of admitted prior art.

The reference is again relied upon substantially as set forth above. If, for the purpose of anticipation, the reference is believed to teach such a number of different embodiments that the specific parameters of each of the claims cannot be considered to be in possession of the skilled artisan, the Examiner believes that, alternatively, each of the claimed embodiments is at most a minor modification to one of ordinary skill. Alternatively, Applicants appear to admit that the prior art teaches that when a foamed resin component is joined to a surface material with smaller cell size in the joint area, the molding irregularity is removed (Specification, pg. 5, lines 11-21), as such it would have been obvious to one of ordinary skill in the art to modify EP '447 to place the surface layer against the side of foam with smaller expansion ratio (i.e., small cell size) as taught by admitted prior art, motivated by the desire to reduce irregularity in the molded laminate.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09/826,012
Art Unit: 1771

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October 4, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
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Daniel Zinker